

Amendment and Response

Applicant: Barbara Elaine Blair et al.

Serial No.: 10/632,071

Filed: July 31, 2003

Docket No.: 10012692-1

Title: SYSTEM AND METHOD FOR TRANSFERRING DIGITAL CONTENT ON A MEMORY CARD

REMARKS

The following remarks are made in response to the Non-Final Office Action mailed May 16, 2008, in which claims 1, 2, 4, 6, 9, 10, 14-16, and 18-24 were rejected. Claims 3, 5, 7-8, 11-13, and 17 were previously canceled. With this Response, claims 1-2, 4, 6, 9-10, 14-16, 18, 21, and 24 have been amended, claims 20, 22-23 have been canceled, and new claim 25 has been added. Claims 1, 2, 4, 6, 9-10, 14-16, 18-19, 21, and 24-25 are pending in the application and are presented for reconsideration and allowance.

Claim Rejections under 35 U.S.C. § 102

In the Office Action, claims 1, 2, 4, 6, 9-10, 14-16, 18-20, and 22-23 were rejected under 35 U.S.C. 102(b) as being anticipated by Iida US Patent 5,900,608 (the Iida Patent).

Applicants' independent claim 1 recites a digital content transfer system comprising a rewritable audio memory card and a transfer appliance.

The Iida Patent discloses including a system for purchasing a personal recording media, resulting in custom production of an MD containing musical compositions selected by the user. See, for example, at least Column 1, lines 11-17 and Column 9, lines 6-14. While not expressly disclosed in the Iida Patent, the numerous references to "MD" throughout the Iida Patent (e.g., Column 1, line 15) apparently refer to a Mini Disc, a smaller form of the ubiquitous compact disc (CD). As used in the system of the Iida Patent, a one-time writing of the selected, purchased musical compositions is made onto the MD. See the Iida Patent, for example, at least at Column 32, lines 1-2 or at Column 36, lines 33-36.

In sharp contrast, Applicants' independent claim 1 recites that the digital content transfer system includes a **rewritable** audio memory card (which defines a memory device independent of, and separate from, a media player) that is configured to store at least one portable audio file.

In further contrast to the Iida Patent, Applicants' independent claim 1 specifies that the memory card reader of the transfer appliance is configured to removably receive, via slidable insertion, the rewritable audio memory card, wherein the memory card reader is configured to **read** the at least one portable audio file from the rewritable audio memory card **and** configured to **write** the at least one portable audio file into the rewritable audio memory card.

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Instead of this claimed feature, the Iida Patent discloses several systems each of which include an MD writer for writing selected musical compositions onto the MD. See, for example, at least Column 32, lines 1-2 and Column 36, lines 33-36; see also MD writer 28 in Figure 1, MD writer 100 in Figure 14, MD writer 1211 in Figure 24, MD writer in Figure 32 and the associated descriptions.

Applicants' independent claim 1 also specifies that a controller is configured to direct user-initiated transfer of the at least one portable audio file, via a network communication link and independent of a personal computer, between an internet-located digital content service provider and the memory card reader.

Moreover, in further sharp contrast to the Iida Patent, Applicant's independent claim 1 specifies wherein the user-initiated transfer includes: (1) **selectively sending** the at least one portable audio file **from** the rewritable audio memory card **directly to** the internet-located digital content service provider; **and** (2) **selectively receiving** the at least one portable audio file **into** the rewritable audio memory card **directly from** the internet-located digital content service provider.

Instead, the Iida Patent describes several examples of a one-way system that merely provides for transferring purchased musical compositions to MD production application accepting system (herein AAS) for one-time writing/recording onto an MD. The recorded MD is recorded at an AAS of a store or user kiosk (see, for example, at least Column 9, lines 15 - Column 14, line 47), or recorded at the user's home (see, for example, at least Column 31 and Column 32, lines 1-2), or recorded elsewhere and then physically sent to the user's home (see, for example, at least Column 15, lines 15-22 or Column 29, line 64 - Column 30, line 52 in association with Figure 31).

However, there is no apparent provision in the Iida Patent for selectively sending, via a single appliance, the at least one portable audio file **from** the rewritable audio memory card directly **to** the internet-located digital content service provider, as recited in Applicants' independent claim 1.

This difference puts the recordable media purchasing system of the Iida Patent in a much different category than the system of Applicants' independent claim 1. In particular, because Applicants' claimed system enables transfer via **both selectively sending** and **selectively receiving** portable audio files (from and to) the audio memory card (via the **single**

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appliance), which is **rewritable**, Applicants' system offers a much more versatile bidirectional mechanism for handling portable audio files.

For at least these reasons, the Iida Patent fails to anticipate and fails to reasonably render obvious Applicants' independent claim 1, and therefore Applicants respectfully submit that independent claim 1 is patentable and allowable over the Iida Patent. Dependent claims 2, 4, 6, and 9-10 are believed to be allowable as they further define patentably distinct independent claim 1.

Applicants' independent claim 14 comprises a method of transferring a portable music file independent of a personal computer.

For at least substantially the same reasons previously presented for the patentability of Applicants' independent claim 1, Applicants' independent claim 14 is patentable over the Iida Patent.

In particular, the Iida Patent fails to disclose a rewritable memory card using a method including removably, slidably inserting into a **single stand-alone** appliance, independent of the personal computer, a plurality of **rewritable** memory cards including at least one of a rewritable music memory card and a rewritable multimedia memory card, wherein the respective rewritable memory cards define a memory device independent of, and separate from, a media player, as recited in Applicants' independent claim 14. As noted before, the Iida Patent discloses one-time writing to MDs, not rewritable memory cards as claimed by Applicants which gives Applicants' system much greater versatility.

In sharp contrast to the single stand-alone appliance (independent of a personal computer) recited in Applicants method of claim 14, in the Iida Patent a customer interacts with several different appliances/mechanisms before achieving completion of a transfer of selected, purchased musical compositions culminating in a recorded MD. For example, when at home, in order to complete the full sequence of selecting the musical compositions, printing a jacket, and recording the musical compositions (among other steps) the user interacts with at least a viewer 2108, an MD writer 2106, a printer 2107, an MD production application accepting system 2101 (including a PC/TV), and a card reader (Figure 35). See, for example, at least Figures 32, 35 and Column 30, line 53 – Column 31, line 34; Column 32, lines 26-40.; see also Column 17, lines 27-60 in association with at least Figure 14.

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Title: SYSTEM AND METHOD FOR TRANSFERRING DIGITAL CONTENT ON A MEMORY CARD

Accordingly, the Iida Patent effectively teaches away from Applicants' claimed method that uses a single stand-alone appliance to effect the transfer of the portable music files.

In further contrast to the Iida Patent, Applicants' independent claim 14 recites that the method includes providing **bidirectional transfer**, via the single stand-alone appliance independent of the personal computer and via an internet communication link, of the portable music file directly between an internet-located digital content service provider and at least one of the respective rewritable memory cards. The method further comprises selectively operating the single appliance in one of a first mode or a second mode with operation in the first mode including receiving the portable music file from the internet-located digital content service provider **directly** into at least one of the respective rewritable memory cards and **operation in the second mode** including **transmitting** the portable music file from at least one of the respective rewritable memory cards (via the memory card reader of the single appliance) **directly** to the internet-located digital content service provider.

Again, as noted before, this **bidirectional transfer capability** makes Applicants' system much more versatile than the more complex one-way downloading mechanism of the Iida Patent from a source (e.g., backchannel company 20 in Figure 1, backchannel company 1200 in Figure 24) to an application accepting system (AAS) located in a kiosk, store or home (see the previously referenced examples), in which the AAS later writes the downloaded musical compositions onto the MD. Apparently, no provision is made in MD production AAS of the Iida Patent to enable the user to transfer portable music files in the other direction, i.e. from the user to the source of the musical compositions (e.g., back channel company).

For at least these reasons, the Iida Patent fails to anticipate and/or reasonably make obvious Applicants' independent claim 14, and therefore Applicants respectfully submit that independent claim 14 is patentable and allowable over the Iida Patent. Dependent claims 15-16 and 18-19 are believed to be allowable as they further define patentably distinct independent claim 14.

In addition, Applicants' dependent claim 18 further specifies that during operation in the first mode, receiving the portable music file (via the internet communication link and via

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the single stand-alone appliance) comprises performing a download function via one-touch activation of the single stand-alone appliance, by using pre-defined download settings without otherwise accessing the user interface of the single stand-will appliance, to cause transfer of the portable music file from the internet-located digital content service provider to the single appliance.

In sharp contrast, the Iida Patent involves a multi-step process of interacting with many choices via a user interface and involving multiple appliances before any transfer can take place. In Applicants' claimed method, one can quickly commence a download or transmission via one-touch activation using pre-defined download settings, as specified in Applicants' claim 18.

For at least these reasons, the Iida Patent fails to anticipate or reasonably make obvious Applicants' claim 18, and therefore Applicants respectfully submit that dependent claim 18 is patentable and allowable over the Iida Patent.

In light of the above, Applicants respectfully request withdrawal of the above rejections of claims 1, 2, 4, 6, 9-10, 14-16, 18-20, and 22-23 under 35 U.S.C. §102 and respectfully request allowance of these claims.

Claim Rejections under 35 U.S.C. § 103

In the Office Action, claims 21 and 24 were rejected under 35 U.S.C. 103 as being unpatentable over the Iida Patent in view of the Official Notice. Dependent claims 21 and 24 are believed to be allowable because they further define patentably distinct independent claim 1 and claim 14, respectively.

In light of the above, Applicants respectfully request withdrawal of the above rejections of claims 21 and 24 under 35 U.S.C. §103 and respectfully request allowance of these claims.

New Claims

Applicants also present new claim 25, which depends from independent claim of 14 and further specifies performing a transmit function via a one-touch activation of the single stand-alone appliance, by using predefined transmit settings and without otherwise accessing

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Title: SYSTEM AND METHOD FOR TRANSFERRING DIGITAL CONTENT ON A MEMORY CARD

a user interface of the single stand-alone appliance, to cause transfer of the portable music file from the single stand-alone appliance to the internet-located digital content service provider.

Applicants respectfully submit that new claim 25 defines over the art of record. Accordingly, favorable consideration and allowance of claim 25 is respectfully requested

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Title: SYSTEM AND METHOD FOR TRANSFERRING DIGITAL CONTENT ON A MEMORY CARD

CONCLUSION

In view of the above, Applicants respectfully submit that pending claims 1, 2, 4, 6, 9, 10, 14-16, 18-19, 21, and 25 are in form for allowance and are not taught or suggested by the cited references. Therefore, reconsideration and withdrawal of the rejections and allowance of claims 1, 2, 4, 6, 9, 10, 14-16, 18-19, 21, and 25 is respectfully requested.

No fees are required under 37 C.F.R. 1.16(h)(i). However, if such fees are required, the Patent Office is hereby authorized to charge Deposit Account No. 08-2025.

The Examiner is invited to contact the Applicants' representative at the below-listed telephone numbers to facilitate prosecution of this application.

Any inquiry regarding this Amendment and Response should be directed to either Paul S. Grunzweig at Telephone No. (612) 767-2504, Facsimile No. (612) 573-2005 or Manisha Chakrabarti at Telephone No. Phone (630) 355-3376, Facsimile No. (630) 355-3376. In addition, all correspondence should continue to be directed to the following address:

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Respectfully submitted,

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